UNITED STATES PATENT AND TRADEMARK OFFICE

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/437,496	11/10/1999	ATSUSHI INOUE	040301/0577	8061

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EXAMINER
NGUYEN, PHUOC H

ART UNIT	PAPER NUMBER
2143	

DATE MAILED: 07/12/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

PTO-90C (Rev. 10/03)

	Application No.	**Applicant(s)**
	09/437,496	INOUE ET AL.
Office Action Summary	**Examiner**	**Art Unit**	
	Phuoc H. Nguyen	2143	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE <u>3</u> MONTH(S) FROM
THE MAILING DATE OF THIS COMMUNICATION.
- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed
  after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
  Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any
  earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on <u>29 March 2005</u>.

2a)☒ This action is **FINAL**.   2b)☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is
closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) <u>1-12,15-21 and 24</u> is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) <u>1-12,15-21 and 24</u> is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All   b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage
application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1)☐ Notice of References Cited (PTO-892)
2)☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3)☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
    Paper No(s)/Mail Date <u>April 29, 2005</u>.

4)☐ Interview Summary (PTO-413)
    Paper No(s)/Mail Date. _____ .
5)☐ Notice of Informal Patent Application (PTO-152)
6)☐ Other: _____ .

DETAILED ACTION

Response to Amendment

1.   This office action is in response to the amendment filed on March 29, 2005.

Previous office action contained claims 1-12, 15-21, and 24. Applicant amended claims

1,15,17,18,19, and 20. Amendment filed on March 29, 2005 have been entered and made

of record. Therefore, pending claims 1-12, 15-21, and 24 is presented for further

consideration and examination.

Response to Arguments

2.   Applicant's arguments filed March 29, 2005 have been fully considered but they

are not persuasive.

The applicant argued in page 10 first and second paragraph for claims 1-12, 17,

19, and 24 that the cited references by Wicks in view of Schwartz (particularly

Schwartz's reference) do not teach or suggest the following limitations: first, uploading

locally the setup data or input data of the application program from a nearby computer

into the portable terminal device via a local network; second, automatically setting the

setup data or input data into the portable terminal device without requiring any user

operation using the user interface; and third, the conversion of the uploaded data into a

form utilizable by the application program on the portable terminal device. Similarly, the

applicant argued in page 10 first and second paragraph for claims 15-16, 18, and 20-21

that the cited reference by Schwartz fails to disclose any teaching for returning a reply

containing a prescribed information related to the specified type of application program

that is setup data or input data of the application program stored in the computer device,

via the local network, such that the setup data or input data can be uploaded via the local

network and automatically set into the portable terminal device without using a user

interface, in a form utilizable by the application program on the portable terminal device.

The examiner respectfully and clearly addresses only the first set of arguments

because the two sets of arguments are similarly directed to the same issues. The

examiner strongly believes the secondary reference by Schwartz discloses or suggests the

three missing limitations in the primary reference. First, Schwartz discloses the

limitation of uploading locally the setup data or input data of the application program

from a nearby computer into the portable terminal device via a local network in Figure 1

column 6 lines 41-44 wherein the computer device 31 as the nearby computer pushes data

from server 51 (as uploading locally) to the device 11 as the portable terminal device.

Second, Schwartz discloses the limitation of automatically setting the setup data or input

data into the portable terminal device without requiring any user operation using the user

interface in column 5 lines 3-4 wherein the application within of the device 11

automatically processes and displays the input data upload by the nearby computer 31.

Third, Schwartz also discloses the limitation of the conversion of the uploaded data into a

form utilizable by the application program on the portable terminal device in column 6

lines 35-50 wherein the data is converted or translated by a module into different format

as compatible with HDTP for optimally in wireless devices.

3.   Claims 2-12, 16, 21, and 24 are rejected at least by virtual of their dependency on

independent and by other reasons set forth in the previous office action.

4.   According rejections for claims 1-12, 15-21, and 24 are presented as below.

Claim Rejections - 35 USC § 103

5.   The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all

obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set
> forth in section 102 of this title, if the differences between the subject matter sought to be patented and
> the prior art are such that the subject matter as a whole would have been obvious at the time the
> invention was made to a person having ordinary skill in the art to which said subject matter pertains.
> Patentability shall not be negatived by the manner in which the invention was made.

6.   Claims 1-12,17,19, and 24 are rejected under 35 U.S.C. 103(a) as being

unpatentable over Wicks et al. (Hereafter, Wicks) U.S. Patent 5,796,394 in view of

Schwartz et al. (Hereafter, Schwartz) U.S. Patent 6,243,739.

7.   Referring to claims 1,17, and 19, Wicks reference disclose a network connection

unit configured to establish a connection to a computer network (Fig. 1; and col. 5, lines

10-13); a local network connection unit configured to establish a connection to a local

network different from the computer network, the local network being a network locally

defined among the portable terminal device and at least one other computer device (Fig.

1); and a processing unit (CPU inside mobile 110); however, Wicks fails to teach a

processing unit configured to obtain a prescribed information regarding the computer

network that is necessary or utilizable in operating an application program to be operated

on the portable terminal device by being connected to the computer network and that is

setup data or input data for the application program, from said at least one other computer

device connected to the portable terminal device via the local network through the local

network connection unit, carry out a prescribed processing to enter the setup data or the

input data into the portable terminal device in a form utilizable by application program,

without using the user interface, according to at least a part of the prescribed information, and execute the application program by using a result of the prescribed processing and being connected to the computer network through the network connection unit.

Schwartz teaches processing unit configured to obtain a prescribed information regarding the computer network (e.g. communication between the portable device 11 an d server 51 according the figure) that is necessary or utilizable in operating an application program (e.g. browser) to be operated on the portable terminal device by being connected to the computer network (e.g. portable device 11 obtain information from the server 51) and that is setup data or input data (e.g. information) for the application program, from said at least one other computer device (e.g. computer 31) connected to the portable terminal device via the local network through the local network connection unit (e.g. the portable device 11 received the information from the server 51 through the computer 31), carry out a prescribed processing to enter the setup data or the input data into the portable terminal device in a form utilizable (e.g. computer 31 received the HTTP information from the server 51 and automatically translated the HTTP information into HDTP information which is utilizable from the portable device) by application program, without using the user interface, according to at least a part of the prescribed information, and execute the application program by using a result of the prescribed processing and being connected to the computer network through the network connection (col. 6, lines 35-44).

It would have been obvious to one of the ordinary skill in the art at the time of the invention was made to incorporate Schwartz's teaching into Wicks's method to enter the setup data or the input data into the portable terminal device in a form utilizable by the application program, without the user interface, as a result, it reduces the bandwidth

requirements of the communication channel and reduces the processing required by

remote device 11 to parse and interpret the information.

8.   Referring to claim 2, Wicks reference discloses the processing unit carries out the

prescribed processing to make a prescribed setup regarding the computer network (col. 3,

lines 52-67).

9.   Referring to claim 3, Wicks reference disclose the processing unit makes the

prescribed setup by storing said at least a part of the prescribed information into a

prescribed memory region for the application program, either as obtained from said at

least one other computer device or by converting said at least a part of the prescribed

information into a format matching with the application program and/or a user interface

of the portable terminal device (col. 2, lines 59 through col. 3, lines 13).

10.   Referring to claim 4, Wicks reference disclose the processing unit obtains-the

prescribed information related to a specified type of application program that exists in

said at least one other computer device (col. 7, lines 54 through col. 8, lines 20).

11.   Referring to claim 5, Wicks reference discloses a local network connection unit

configured to establish a connection to a local network different from the computer

network, the local network being a network locally defined among the portable terminal

device and at least one other computer device (Fig. 1); and a processing unit (CPU inside

mobile 110); however, Wicks fails teach the processing unit obtains the prescribed

information by transmitting to said at least one other computer device via the local

network a first request for obtaining the identification information for identifying said

specified type of application program, receiving a reply containing the identification

information from said at least one other computer device via the local network in

response to the first request, transmitting to said at least one other computer device via

the local network a second request for obtain the prescribed information according to the

identification information contained in the reply, and receiving the prescribed

information from said at least one other computer device via the local network in

response to the second request.

Schwartz teaches the processing unit obtains the prescribed information by

transmitting to said at least one other computer device via the local network a first

request for obtaining the identification information for identifying said specified type of

application program, receiving a reply containing the identification information from said

at least one other computer device via the local network in response to the first request,

transmitting to said at least one other computer device via the local network a second

request for obtain the prescribed information according to the identification information

contained in the reply, and receiving the prescribed information from said at least one

other computer device via the local network in response to the second request (col. 7, 2°d

paragraph.

It would have been obvious to one of the ordinary skill in the art at the time of the

invention was made to incorporate Schwartz's teaching into Wicks's method to obtain the

prescribed information according to specific type of application program, in order for the

computer to check whether the portable terminal is entitled to initiate a session.

12.   Referring to claim 6, Wicks reference disclose the local network enables data

exchanges between the portable terminal device and said at least one other computer

device by using a wireless LAN (Local Area Network), a point-to-point wireless device,

or an infrared as a medium (col. 4, lines 63-67).

13.   Referring to claim 7, Wicks reference disclose the processing unit carries out data exchanges on the local network only with a computer device that is authenticated by a prescribed mutual authentication procedure (col. 11, lines 17-32).

14.   Referring to claim 8, Wicks reference disclose the processing unit carries out a procedure for obtaining the prescribed information for each one of a plurality of application programs installed on the portable terminal device, at a timing of activation of the portable terminal device (col. 10, lines 1-24).

15.   Referring to claim 9, Wicks reference disclose the processing unit carries out a procedure for obtaining the prescribed information for the application program at a timing of activation of the application program (col. 10, lines 1-24).

16.   Referring to claim 10, Wicks reference disclose the processing unit carries out a procedure for transferring the prescribed information obtained from a first computer device via the local network to a second computer connected to the local network (col. 9, lines 36-44).

17.   Referring to claim 11, Wicks reference disclose the processing unit carries out a procedure for transferring the prescribed information obtained via the local network to one or a plurality of computer devices connected to the local network (col. 9, lines 36-- 44).

18.   Referring to claim 12, Wicks reference discloses the network connection unit carries out communications via the computer network through a radio base station (Fig. 1; col. 9, lines 36-44).

19.   Referring to claim 24, Wicks reference discloses the processing unit executes the application program for an email handler (Abstract.).

Claim Rejections - 35 USC § 102

20.   The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that

form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by
> another filed in the United States before the invention by the applicant for patent or (2) a patent granted
> on an application for patent by another filed in the United States before the invention by the applicant
> for patent, except that an international application filed under the treaty defined in section 351(a) shall
> have the effects for purposes of this subsection of an application filed in the United States only if the
> international application designated the United States and was published under Article 21(2) of such
> treaty in the English language.

21.   Claims 15,16,18,20 and 21 are rejected under 35 U.S.C. 102(e) as being

anticipated by Schwartz.

22.   Referring to claims 15,18, and 20, Schwartz reference discloses a local network

connection unit configured to establish a connection to a local network that is locally

defined among the computer device and a portable terminal device (Schwartz's figure

discloses a portable device 11 is locally connected to the computer 31); a processing unit

configured to return a reply containing an identification information for identifying a

specified type of application program that exists in the computer device, or a prescribed

information related to said specified type of application program that is setup data or

input data of the application program to be entered into the portable terminal device in a

form utilizable by the application program, without using a user interface of the portable

terminal device, in response to a request received from the portable terminal device via

the local network through the local network connection unit utilizable (e.g. computer 31

received the HTTP information from the server 51 and automatically translated the HTTP

information into HDTP information which is utilizable from the portable device) (col. 6,

lines 35-44).

23.   Referring to claim 16, Schwartz reference discloses processing unit receives from

the portable terminal device via the local network a first request for obtaining the

identification information, transmits a first reply containing the identification information

to the portable terminal device via the local network in response to the first request,

receives from the portable terminal device via the local network a second request for

obtaining the prescribed information, and transmits a second reply containing the

prescribed information to the portable terminal device via the local network in response

to the second request (col. 7, 2nd paragraph).

24.   Referring to claim 21, Schwartz reference discloses a local network connection

unit configured to establish a connection to a local network that is locally defined among

the computer device and a portable terminal (e.g. portable device 11 communicate with

computer 31) and identifying a specified type of application program that exists in the

computer device, or a prescribed information related to said specified type of application

program, in response to a request received from the portable terminal device via the local

network through the local network connection unit (col. 7, 2nd paragraph) the data to be

downloaded into the computer device was previously uploaded to the portable terminal

device from another device via the local network, and the data to be downloaded into the

computer device only passes through the portable terminal device as the data is sent from

the another computer device to the computer device (col. 6, lines 36-44).

Conclusion

25.   **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of

time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE

MONTHS from the mailing date of this action. In the event a first reply is filed within

TWO MONTHS of the mailing date of this final action and the advisory action is not

mailed until after the end of the THREE-MONTH shortened statutory period, then the

shortened statutory period will expire on the date the advisory action is mailed, and any

extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than

SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the

examiner should be directed to Phuoc H. Nguyen whose telephone number is 571-272-

3919. The examiner can normally be reached on Monday - Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's

supervisor, David Wiley can be reached on 571-272-3923. The fax phone number for the

organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the

Patent Application Information Retrieval (PAIR) system. Status information for

published applications may be obtained from either Private PAIR or Public PAIR. Status

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more information about the PAIR system, see http://pair-direct.uspto.gov. Should you

have questions on access to the Private PAIR system, contact the Electronic Business

Center (EBC) at 866-217-9197 (toll-free).

Phuoc H Nguyen
Examiner
Art Unit 2143

June 23, 2005

DAVID WILEY
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100